

Attorney Docket No.: 1243.LUKP:123US
U.S. Patent Application No. 10/711,823
Reply to Office Action of August 29, 2006
November 29, 2006

Remarks

Amendments to the Specification

The Examiner has objected to paragraph [0012], line 4 of the specification noting that “selector switch 2” should read “selector shaft 2”. Applicants have amended paragraph [0012] according to Examiner’s recommendations, and respectfully request withdrawal of the objection to the disclosure.

Rejection of Claims 1 and 3-9 Under 35 U.S.C. § 112

The Examiner has rejected Claims 1 and 3-9 under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. Specifically, the Examiner states that how the shift finger and disengaging elements operate the gearshift rails is critical or essential to the practice of the invention, which description the Examiner asserted is not disclosed in the specification, the claims, or the drawings. In addition, the Examiner stated that how the shift finger shifts, how the disengaging members disengage, and with what the shift finger and disengaging member communicate with on the shift rails to move them are not disclosed. Applicants respectfully traverse these assertions and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, first paragraph, based upon the following reasons.

Applicants respectfully submit that U.S. Patent No. 4,584,895 (*Holmes*) describes current state of the art with respect to transmission shift controls. In particular, *Holmes* (Col. 3, lines 43-52) details how a shift finger and disengaging members operate gearshift rails, how the shift fingers shift, and what the shift finger and disengaging member communicate with on the shift rails to move them. For example, *Holmes* states “each of the shift rails 58, 56, and 54, respectively, is provided with a notch or a shift block member 60, 62, and 64, respectively, for engagement by the end or shift finger of a conventional shift lever (not shown) as is well known in the prior art, the end of the shift lever is moved in the direction of arrow 66 to align the shift fork with one of the shift rails and then is moved in the direction of arrow 68 to engage the notch or shift lock mechanism to cause an axial movement of the selected shift rail and shift fork

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carried thereby.” In addition, *Holmes* (Col. 5, lines 1-10) describes how the disengaging members disengage. *Holmes* states “to engage or disengage first and second speeds, the shift finger is moved into alignment with surfaces 96 and 98 and to engage or disengage fourth or fifth speeds the shift finger is moved into alignment with surfaces 92 and 94.

Additionally, United States Patent No. 7,093,511 (*Norum et al.*) describes current state of the art with respect to transmission shift controls. In particular, Figures 22, 23a and 23b and Column 26, line 42 through Column 29, line 16 describe such transmission shift controls. Even more specifically, Column 27, lines 3-64 describe how a shift finger and disengaging members operate gearshift rails, how shift fingers shift, and what the shift finger and disengaging member communicate with on the shift rails to move them.

“A patent need not teach, **and preferably omits**, what is well known in the art.” *In re Buchner*, 929 F.2d 660, 661, 18 U.S.P.Q.2d 1331, 1332 (Fed. Cir. 1991) (Emphasis added) (citations omitted); M.P.E.P. § 2164.01. Applicants courteously submit that the patents to *Holmes* and *Norum et al.* are part of the general knowledge in the relevant field of art, in particular regarding how a shift finger and disengaging members operate gearshift rails, how shift fingers shift, and what the shift finger and disengaging member communicate with on the shift rails to move them. Applicants’ disclosure need not read as a treatise on subject matter which is already in the public domain and within the purview of one skilled in the art. *Holmes* and/or *Norum et al.* substantiate that the alleged deficient disclosure is already in the public domain, and consequently, Applicants’ disclosure need not dwell on such details. Hence, reconsideration and withdrawal of this rejection is appropriate and courteously requested.

Rejection of Claims 1 and 3-9 Under § 112

The Examiner has rejected Claims 1 and 3-9 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. More specifically, the Examiner asserted that it is unclear as to what the finger and disengaging element are arranged on in Claim 1 when it recites, “a single

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selector shaft driven by a drive and arranged in a housing upon which are arranged a shift finger and disengaging elements,” and that Claims 5 and 7 are unclear as to how the rods are opposite each other since the selector shaft has multiple axis of symmetry and both a horizontal axis and a vertical axis for the rods to be opposite about.” Applicants respectfully traverse this rejection and request reconsideration based on the following reasons.

Claim 1 has been amended to recite “wherein said single selector shaft is driven by said drive unit and is arranged in said gearbox actuator housing, and said shift fingers and disengaging elements are arranged to operate the gearshift rails”. Applicants respectfully submit that amended Claim 1 clearly recites the arrangement of the shift finger and disengaging element. Hence, Claim 1 is in condition for allowance, which action is courteously requested.

Claims 5 and 7 have been amended to recite “said first and second upper protruding rods arranged opposite each other with respect to the selector shaft, and said first and second lower protruding rods arranged opposite each other with respect to the selector shaft” and “said first and second upper protruding rods arranged symmetrically opposite each other with respect to the selector shaft, and said first and second lower protruding rods arranged symmetrically opposite each other with respect to the selector shaft”, respectively. Applicants respectfully request reconsideration and withdrawal of the rejections of Claims 5 and 7.

Rejection of Claims 1 and 3-9 Under 35 U.S.C. § 102(b)

The Examiner has rejected Claims 1 and 3-9 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,082,215 (*Jerwick*). Applicants have amended Claim 1, and respectfully traverse the rejection of Claims 1 and 3-9, and request reconsideration based on the following reasons.

“A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference.” *Vandergaal Bros. v. Union Oil of California*, 814 F.2d 628, 631; 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131 (Emphasis added). Applicants respectfully submit that *Jerwick* fails to anticipate

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amended independent Claim 1 as it fails to disclose every element of the claim. Claim 1 has been amended to recite a gearbox actuator comprising a gearbox actuator housing, a drive unit, a single selector shaft, and a bearing arrangement operatively arranged to support gearshift rails. In contrast, *Jerwick* does not teach a drive unit or a single selector shaft driven by a drive unit. Applicants respectfully submit that *Jerwick* defines reference 36 as shift forks and not a drive as asserted by the Examiner. Since *Jerwick* does not teach a drive unit or a single selector shaft driven by the drive unit, Claim 1 is not anticipated by *Jerwick*. Applicants respectfully request reconsideration and allowance of Claim 1 as amended.

Claims 3-9 depend from Claim 1 and thus incorporate all the limitations of that claim. Because, as discussed above, *Jerwick* fails to anticipate all the elements of Claim 1, it also fails to anticipate Claims 3-9, due to their dependency from Claim 1. Thus, Applicants respectfully request the removal of the rejections of Claims 3-9 and allowance of the same.

Conclusion

Applicants respectfully submit that the application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned agent of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,



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